



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,033	09/28/2001	Joshua R. Smith	103140-0012U1	7207
24267	7590	05/29/2007	EXAMINER	
CESARI AND MCKENNA, LLP			CASLER, TRACI	
88 BLACK FALCON AVENUE			ART UNIT	PAPER NUMBER
BOSTON, MA 02210			3629	
			MAIL DATE	DELIVERY MODE
			05/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/966,033

Applicant(s)

SMITH ET AL.

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,4,21-24 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 21-24 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is in response to papers filed on March 29, 2007.

Claims 2, 4, 21-24 and 28-30 are pending.

Claims 2, 4, 21-23 and 28-30 have been amended.

Claims 2, 4, 21-24 and 28-30 are rejected.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 29, 2007 has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 4 21-22 and 29-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 2 recites the limitation "the respective messages" in step iv. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 4 recites the limitation "the associated information" in B. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3629

6. Claim 21 recites the limitation "the associated information " in E. ii. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 22 recites the limitation "the associated images" in step F ii. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 29 recites the limitation "the transaction" and "the related transaction" in Steps A ii and B respectively. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 30 recites the limitation "the associated information" in step A iv and step B. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 4, 21-24 and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,285,916 Multi-stage Parcel Tracking System; Kadaba et al.; hereinafter referred to as Kadaba.
2. As to claims 2, 4, 21-24 and 28-30 Kadaba teaches
  - a. Matching user id, tracking numbers, names etc with parcels being shipped and shipping status(C. 7 I. 30-35)
3. Displaying a message to a user indicating the status of the shipped parcel(C. 7 I. 65-67 & C. 8 I. 1-2). The examiner notes that "information relating to contents" is also status information. If there parcel is in transit then the contents of the parcel are therefore in-transit as well. However, as to applicants "information relating to contents"

Art Unit: 3629

and "image of contents" these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. **The steps associating the images and information would be performed regardless of the information or images presented.** Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

Allowing the user to view the information over a computer network(C. 8 l. 9-15).

Computers for displaying tracking information to the user(C. 9 l. 43-46).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 2 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patnet 6285916 Multi-stage parcel tracking system; Kadaba; hereinafter referred to

Art Unit: 3629

as Kadaba, in view of US Patent 5860068; Method and System For Custom Manufacture and Delivery of Data Product; Cook; hereinafter referred to as Cook.

4. As to claims 2 and 28 Kadaba teaches

b. Matching user id, tracking numbers, names etc with parcels being shipped and shipping status(C. 7 I. 30-35)

5. Displaying a message to a user indicating the status of the shipped parcel(C. 7 I. 65-67 & C. 8 I. 1-2).

6. Allowing the user to view the information over a computer network(C. 8 I. 9-15). And computers for displaying tracking information to the user(C. 9 I. 43-46).

13. Kadaba fails to teach linking the delivery status information with messages from the sender. However, Cook teaches email confirmation messages that include hyperlinks to provide order status updates to the user (C. 3 I. 35-45; C. 10 I. 15-20).

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 2 and 28 have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments filed 4, 21-24 and 29-30 have been fully considered but they are not persuasive. As to applicants that the "associating" is a functional portion of the claim, the examiner notes the non-functional descriptive matter was not drawn towards the associating, it was directed toward the information being association. The steps of associating are performed the same regardless of that information is being associated with the delivery status. The information itself has not functional value, nothing besides displaying the information is being done with the information.

Art Unit: 3629

Regardless if it is a textual description of the product or a visual image of the product it is merely being displayed to the user.

16. As to applicant arguments that kadaba is not equipped to display or receive images, the applicant's attention is drawn to Fig. 4 and 10 B, which screen shots of the information being displayed in the system. Accordingly, Kadaba recites the system take place with PC's and PDA, each of which inherently have a GUI for receiving and sending images.

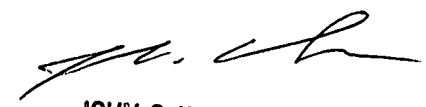
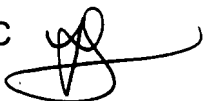
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600